

REMARKS

Claims 1-24 are pending. Claims 1-16 are rejected under 35 U.S.C. §101. Claims 1-24 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

Applicants note that claims 4, 6 and 12 were amended to correct typographical mistakes and not to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 4, 6 and 12. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 4, 6 and 12 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner rejects claims 1-16 under 35 U.S.C. §101 because the claims fail to produce a useful, concrete, and tangible result. Office Action (6/20/2007), pages 2-3. Applicants respectfully traverse.

The Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claims 1-8 are directed to a computer program product, which is not outside the four statutory categories, for providing an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site (see page 2, lines 10-13 of Applicants' Specification). Claims 9-16 are directed to a system, which is not outside the four

statutory categories, for providing an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site.

Applicants respectfully contend that the claimed inventions in claims 1-16 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, providing an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a

"smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary

of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the Specification.

In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

The Examiner contends that the cited claims do not produce a useful, tangible result. However, claims 1-16 clearly do produce a useful, tangible result, especially when the claims are interpreted in light of the Specification. Applicants' Specification discusses that is desirable to provide an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site. Applicants' Specification, page 2, lines 10-13. Claims 1-16 are clearly directed to providing an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site. Hence, claims 1-16 do produce a useful, concrete and tangible result.

As stated above, the inquiry under 35 U.S.C. §101 is whether there is a practical application, or result. *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601. As discussed above, claims 1-16 are directed to a method and system for providing an e-commerce system that permits a single site to be divided into different security domains and in which users may be accorded privileges in a manner that corresponds to the relationships of the stores supported by the e-commerce site. Hence, the subject matter of claims 1-16 has a practical application within the four statutory categories and is not an idea, a law of nature or a natural phenomenon.

Thus, Applicants respectfully contend that claims 1-16 constitute statutory subject matter. Applicants respectfully assert that the rejections of claims 1-16 under 35 U.S.C. §101 are in error.

Further, the Examiner, citing to page 7 of Applicants' Specification, asserts that the claimed medium and the claimed means refers to a modulated carrier signal and therefore claims 1-16 are directed to non-statutory subject matter. Office Action (6/20/2007), page 2. Applicants respectfully traverse the assertion that the language on page 7 of the Specification indicates that claims 1-16 are directed to non-statutory subject matter.

Applicants note that claims 1-2 and 4-8 were amended to delete the term "means" following the phrase "program code" for clarity and not to overcome prior art or to overcome the Examiner's 101 rejections. Hence, no prosecution history estoppel arises from the amendments to claims 1-2 and 4-8. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1-2 and 4-8 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

## II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1-7, 9-15 and 17-23 under 35 U.S.C. §103(a) as being unpatentable over Win et al. (U.S. Patent No. 6,453,353) (hereinafter "Win") in view of Gillett et al. (U.S. Patent No. 6,760,711) (hereinafter "Gillett"). The Examiner has further rejected claims 8, 16 and 24 under 35 U.S.C. §103(a) as being unpatentable over Win in view of Gillett and in further view of Aull et al. (U.S. Patent No. 7,028,180) (hereinafter "Aull"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

- A. Claims 1-7, 9-15 and 17-23 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Win in view of Gillett.
  - 1. Win and Gillett, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Win and Gillett, taken singly or in combination, do not teach or suggest "a computer program product for implementing electronic commerce systems, each electronic commerce system comprising a web site being accessible by one or more users and comprising a set of on-line stores and a set of organizations, each of the said on-line stores being associated with one of the set of organizations" as recited in claim 1 and similarly in claims 9 and 17. The Examiner cites column 4, lines 20-30 and 34-67 of Win as teaching the above-cited claim limitations. Office Action (6/20/2007), page 3. Applicants respectfully traverse.

Win instead teaches a method and apparatus for controlling access to protected information resources. Column 4, lines 21-22. Win further teaches that information access system 2 comprises a plurality of components including an access server 106, registry server 108, administration application 114, and integration tools 115. Column 4, lines 35-38. Win additionally teaches that the foregoing components cooperate to control access to resources stored on one or more protected servers 104, 112. Column 4, lines 38-40. Further, Win teaches that each component comprises one or more modules and each module provides one or more services to users of the system 2 and administrators. Column 4, lines 41-43. Additionally, Win teaches that users are individuals who have a relationship with an organization and play various roles, and are registered in the system 2. Column 4, lines 44-46. Hence, Win teaches various servers 104, 112 used to store resources which are accessed by users, who are individuals who have a relationship with an organization and play various roles.

There is no language in the cited passage that teaches that each electronic commerce system comprises a web site being accessible by one or more users and comprises a set of on-line stores and a set of organizations. Neither is there any language in the cited passage that teaches that each of the on-line stores being associated with one of the set of organizations. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Win and Gillett, taken singly or in combination, do not teach or suggest "the security domain comprising a subset of the set of organizations and the on-line stores associated with the organizations in the subset" as recited in claim 1 and similarly in claims 9 and 17. The Examiner cites column 3, lines 28-60; column 4, lines 1-10 and column 8, lines 20-40 of Gillett as teaching the above-cited claim limitation. Office Action (6/20/2007), page 4. Applicants respectfully traverse.

Gillett instead teaches that Figure 1 shows an online commerce system 20 in which customers shop for goods and/or services offered by merchants over the Internet 22. Column 3, lines 19-21. Gillett further teaches that the merchant computers 24(1)-24(N), with the assistance of the ISP computer 28, create online stores that are merchant-owned, but physically hosted by the ISP computer 28. Column 3, lines 28-31. Additionally, Gillett teaches that the ISP also has a storage or database 34 that stores commerce data on behalf of the merchants. Column 3, lines 55-56. Furthermore, Gillett teaches that periodically, or in response to a merchant-initiated request, the merchant computer 24(1) checks the ISP database 34 to see if any purchase requests for the merchant's products have been received. Column 8, lines 20-23.

There is no language in the cited passages that teaches a security domain comprising a subset of the set of organizations. Neither is there any language in the cited passages that teaches a security domain comprising a subset of the set of organizations and the on-line stores associated with the organizations in the subset. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Win and Gillett, taken singly or in combination, do not teach or suggest "granting or denying access to a user attempting to access a portion of the web site by determining the user identity for the user and determining the access role associated with the user identity for the security domain corresponding

to the portion of the web site subject to the access attempt" as recited in claim 1 and similarly in claims 9 and 17. The Examiner cites column 3, lines 1-6; column 6, line 10-16; and column 8, lines 10-16, 36-46 of Win as teaching the above-cited claim limitations. Office Action (6/20/2007), page 4. Applicants respectfully traverse.

Win instead teaches that a related feature involves, based on the association, automatically granting access to the resource to all users who have the role when the association is stored; and based on the association, automatically denying access to the resource to all users who do not have the role when the association is un-assigned. Column 3, lines 1-6. Win further teaches that if the login attempt is successful, the system 2 presents the user with a personalized menu that assists the user in identifying and selecting a resource. Column 6, lines 10-12. Additionally, Win teaches that Figure 3C is a state diagram showing processes carried out when the URL is a protected resource and the user is authenticated. Column 8, lines 36-38. Hence, Win teaches granting access to the resource to all users who have the role when the association is stored; and denying access to the resource to all users who do not have the role when the association is un-assigned.

There is no language in the cited passages that teaches granting or denying access to a user attempting to access a portion of the web site by determining the user identity for the user and determining the access role associated with the user identity for the security domain corresponding to the portion of the web site subject to the access attempt. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-7, 10-15 and 18-23 each recite combinations of features of independent claims 1, 9 and 17, respectively, and hence claims 2-7, 10-15 and 18-23 are patentable over Win in view of Gillett for at least the above-stated reasons that claims 1, 9 and 17, respectively, are patentable over Win in view of Gillett.



Claims 2-7, 10-15 and 18-23 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Win in view of Gillett.

For example, Win and Gillett, taken singly or in combination, do not teach or suggest "to define the set of organizations as a tree structure" as recited in claim 4 and similarly in claims 5-6, 12-14 and 20-22. The Examiner cites Figure 1 of Gillett as teaching the above-cited claim limitation. Office Action (6/20/2007), page 5. Applicants respectfully traverse.

There is no depiction in Figure 1 or description of Figure 1 of Gillett that teaches defining a set of organizations as a tree structure. Figure 1 of Gillett instead shows a merchant computer 24 being coupled to an ISP 26 via a network 28. This is not the same as defining a set of organizations as a tree structure. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4-6, 12-14 and 20-22 since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner appears to additionally cite column 5, lines 20-32 and 55-56 of Win as teaching the above-cited claim limitation. Office Action (6/20/2007), page 5. Applicants respectfully traverse.

Win instead teaches that the system 2 enables administrators to implement access rules by defining roles that users play when working for an organization or doing business with an enterprise. Column 5, lines 21-23. Win further teaches that roles and resources are owned by functional groups within the organization. Column 5, lines 55-56.

There is no language in the cited passages that teaches defining a set of organizations as a tree structure. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4-6, 12-14 and 20-22 since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Win and Gillett, taken singly or in combination, do not teach or suggest "defining the security domain to include the selected organization and those organizations in the set that are descendants of the selected organization" as recited in claim 4 and similarly in claims 5-6, 12-14 and 20-22. The Examiner cites column 5, lines 33-39 and 54-56 of Win as teaching the above-cited claim limitation. Office Action (6/20/2007), page 5. Applicants respectfully traverse.

Win instead teaches that roles are defined by information identifying a name of a role and by a functional group in which the role resides. Column 5, lines 34-35. Win further teaches that a functional group is often a department in which similar functions exist. Column 5, lines 35-37. Win additionally teaches that roles and resources are owned by functional groups within the organization. Column 5, lines 55-56.

There is no language in the cited passages that teaches defining the security domain to include the selected organization and those organizations in the set that are descendants of the selected organization. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4-6, 12-14 and 20-22 since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Win and Gillett, taken singly or in combination, do not teach or suggest "maintaining and providing look up functionality for a table comprising rows comprising data representing user identity, organization, access role associations" as recited in claim 7 and similarly in claims 15 and 23. The Examiner cites column 13, lines 50-52; column 15, lines 44-46 of Win and column 16, lines 46-53 as teaching the above-cited claim limitation. Office Action (6/20/2007), pages 5-6. Applicants respectfully traverse.

Win instead teaches that a preferred arrangement of database tables and forms will become apparent. Column 13, lines 50-52. Win further teaches that each user is defined by personal information, login and password information, and account information. Column 15, lines 42-44. Additionally, Win teaches that preferably, the

personal information comprises a first name value, a last name value, an email address value, and a user type value. Column 15, lines 45-47.

There is no language in the cited passages that teaches maintaining and providing look up functionality for a table comprising rows comprising data representing user identity, organization, access role associations. Instead, Win teaches storing personal information for a user, such as a name and an e-mail address. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 7, 15 and 23 since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Win in view of Gillett, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1-7, 9-15 and 17-23. M.P.E.P. §2143.

2. Examiner's reasoning for modifying Win with Gillett to include the missing claim limitations of claims 1, 9 and 17 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Win does not teach "the security domain comprising a subset of the set of organizations and the on-line stores associated with the organizations in the subset" as recited in claim 1 and similarly in claims 9 and 17. Office Action (6/20/2007), page 4. The Examiner asserts that Gillett teaches the above-cited claim limitations. *Id.* The Examiner's reasoning for modifying Win with Gillett to include the above-cited claim limitations is "to set up online stores while having a centralized ISP provide the security and maintenance of the websites thereby diminishing the threat of misuse of information (Gillett, column 1 lines 35-62 and column 1 lines 1-15)." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 1-7, 9-15 and 17-23.

The Examiner's reasoning ("to set up online stores while having a centralized ISP provide the security and maintenance of the websites thereby diminishing the threat of misuse of information") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Win to include the above-indicated missing claim limitations of claims 1, 9 and 17. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7, 9-15 and 17-23. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites column 1, lines 1-15 and 35-62 of Gillett as support for the Examiner's reasoning for modifying Win with Gillett to include the missing claim limitations of claims 1, 9 and 17. Gillett teaches that there is a need for an architecture that provides security at the ISP level to thereby reduce the exposure of ISPs to liability. Column 1, lines 59-62. There is no language in Gillett (and in particular column 1, lines 1-15 and 35-62) that makes any suggestion that by having a security domain comprise a subset of the set of organizations and the on-line stores associated with the organizations in the subset (missing claim limitations) the threat of misuse of information is diminished. The Examiner has simply cited to arbitrary passages in Gillett that mentions the problems in the prior art and that there is a need in the art for an architecture that provides security at the ISP level to thereby reduce the exposure of ISPs to liability. The Examiner has to provide some rationale

connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner's source (column 1, lines 1-15 and 35-62 of Gillett) for the Examiner's reasoning for modifying Win with Gillett to include the above-cited claim limitations does not provide reasons as to why one skilled in the art would modify Win to include the missing claim limitations of claims 1, 9 and 17. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7, 9-15 and 17-23. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Win addresses the problems of permitting rapid and convenient addition of information describing users and resources and propagating the effects of changes in the data model throughout the system. Column 2, lines 34-38. The Examiner has not provided any reasons as to why one skilled in the art would modify Win (which teaches permitting rapid and convenient addition of information describing users and resources and propagating the effects of changes in the data model throughout the system) to have a security domain comprise a subset of the set of organizations and the on-line stores associated with the organizations in the subset (missing claim limitations). The Examiner's rationale ("to set up online stores while having a centralized ISP provide the security and maintenance of the websites thereby diminishing the threat of misuse of information") does not provide such reasoning.

Why would the reason to modify Win (whose purpose is to permit rapid and convenient addition of information describing users and resources and propagate the effects of changes in the data model throughout the system) to have a security domain comprise a subset of the set of organizations and the on-line stores associated with the organizations in the subset (missing claim limitations) be to diminish the threat of misuse of information? Win is not concerned with diminishing the threat of misuse of information. The Examiner cannot completely ignore the teachings of Win in concluding it would have been obvious to modify Win to include the missing claim limitations of claims 1, 9 and 17.<sup>1</sup> Further, what is the rationale connection between

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<sup>1</sup> For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a

diminishing the threat of misuse of information (Examiner's motivation) and having a security domain comprise a subset of the set of organizations and the on-line stores associated with the organizations in the subset (missing claim limitations)? Hence, the Examiner's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Win to include the missing claim limitations of claims 1, 9 and 17. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7, 9-15 and 17-23. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

3. Examiner fails to provide a rationale underpinning for modifying Win with Gillett to include the missing claim limitations of claims 4-6, 12-14 and 20-22.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same

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primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would the secondary reference include it? The Examiner must explain the connection between the teachings of the primary reference and the rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Win does not teach "to define the set of organizations as a tree structure" as recited in claim 4 and similarly in claims 5-6, 12-14 and 20-22. Office Action (6/20/2007), page 5. The Examiner asserts that Gillett teaches the above-cited missing limitation of claims 4-6, 12-14 and 20-22. *Id.* However, the Examiner has not provided any rational underpinning for modifying Win with Gillett to include the above-cited missing claim limitation. Hence, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 4-6, 12-14 and 20-22. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); M.P.E.P. §2143.

B. Claims 8, 16 and 24 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Win in view of Gillett and Aull.

1. Win, Gillett and Aull, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Win, Gillett and Aull, taken singly or in combination, do not teach or suggest "providing user identities with associated access roles at user registration to the web site" as recited in claim 8 and similarly in claims 16 and 24. The Examiner cites column 9, lines 6-21 of Aull as teaching the above-cited claim limitation. Office Action (6/20/2007), page 6. Applicants respectfully traverse.

Aull instead teaches that the process for creating a role certificate begins in operation 200 where the user 132 via his local client platform 128 accesses the registration web server 124 and fills out an electronic form requesting the role certificate. Column 9, lines 6-10. Hence, Aull teaches creating a roll certificate.

There is no language in the cited passage that teaches providing user identities with associated access roles at user registration. Neither is there any language in the cited passage that teaches providing user identities with associated access roles at user registration to the web site. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8, 16 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's reasoning for modifying Win with Aull to include the missing claim limitations of claims 8, 16 and 24 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Win does not teach "providing user identities with associated access roles at user registration to the web site" as recited in claim 8 and similarly in claims 16 and 24. Office Action (6/20/2007), page 6. The Examiner asserts that Aull teaches the above-cited claim limitations. *Id.* The Examiner's reasoning for modifying Win with Aull to include the above-cited claim limitation is "because it offers the advantage of providing a



method by which all parties involved may give their approval to the granting of a role to a user (Aull, column 9 lines 10-21)." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 8, 16 and 24.

The Examiner's reasoning ("because it offers the advantage of providing a method by which all parties involved may give their approval to the granting of a role to a user") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Win to include the above-indicated missing claim limitation of claims 8, 16 and 24. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 8, 16 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites column 9, lines 10-21 of Aull as support for the Examiner's reasoning for modifying Win with Aull to include the missing claim limitation of claims 8, 16 and 24. Aull teaches that in operation 205 the user digitally signs the electronic role form and transmits it to the registration web server 124. Column 9, lines 11-13. Aull further teaches that in operation 210, the registration web server 124 queries directory 108 for personal role approvals. Column 9, lines 13-14. Hence, Aull teaches that the registration web server queries a directory for personal role approvals upon receipt of the electronic role form digitally signed by the user. There is no language in Aull (and in particular column 9, lines 10-21) that makes any suggestion that by providing user identities with associated access roles at user registration to the web site (missing claim limitation) that the registration web server queries a directory for personal role approvals upon receipt of the electronic role form digitally signed by the user. Neither is there any language in Aull (and in particular column 9, lines 10-21) that makes any suggestion that by providing user identities with associated access roles at user registration to the web site (missing claim limitation) that all parties involved may give their approval to the granting of a role to a user (Examiner's motivation). The Examiner has simply cited to arbitrary passages in Aull that discusses the process in creating a role certificate and then concludes that the Examiner has provided appropriate reasoning for modifying Win to incorporate the above-cited missing claim limitation. The

Examiner has to provide some rationale connection between the cited passage that is the source of the Examiner's reasoning and the missing claim limitation. The Examiner's source (column 9, lines 10-21 of Aull) for the Examiner's reasoning for modifying Win with Aull to include the above-cited claim limitation does not provide reasons as to why one skilled in the art would modify Win to include the missing claim limitation of claims 8, 16 and 24. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 8, 16 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Win addresses the problems of permitting rapid and convenient addition of information describing users and resources and propagating the effects of changes in the data model throughout the system. Column 2, lines 34-38. The Examiner has not provided any reasons as to why one skilled in the art would modify Win (which teaches permitting rapid and convenient addition of information describing users and resources and propagating the effects of changes in the data model throughout the system) to provide user identities with associated access roles at user registration to the web site (missing claim limitation). The Examiner's rationale ("because it offers the advantage of providing a method by which all parties involved may give their approval to the granting of a role to a user") does not provide such reasoning.

Why would the reason to modify Win (whose purpose is to permit rapid and convenient addition of information describing users and resources and propagate the effects of changes in the data model throughout the system) to provide user identities with associated access roles at user registration to the web site (missing claim limitation) be to provide a method by which all parties involved may give their approval to the granting of a role to a user? Win is not concerned with providing a method by which all parties involved may give their approval to the granting of a role to a user. The Examiner cannot completely ignore the teachings of Win in concluding it would have been obvious to modify Win to include the missing claim limitation of claims 8, 16 and 24. Further, what is the rationale connection between providing a method by which all parties involved may give their approval to the granting of a role to a user (Examiner's motivation) and providing user identities with

associated access roles at user registration to the web site (missing claim limitation)? Hence, the Examiner's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Win to include the missing claim limitation of claims 8, 16 and 24. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 8, 16 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

III. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-24 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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